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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/517,140

12/07/2004

Yuichi Inada

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6829

32294

7590

05/16/2006

EXAMINER

HECKENBERG JR, DONALD H

SQUIRE, SANDERS & DEMPSEY L.L.P.

14TH FLOOR

8000 TOWERS CRESCENT

TYSONS CORNER, VA 22182

ART UNIT

PAPER NUMBER

1722

DATE MAILED: 05/16/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/517,140

Applicant(s)

INADA ET AL.

Examiner

Donald Heckenberg

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 March 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,8 and 10-12 is/are rejected.
- 7) ☒ Claim(s) 3-7,9 and 13 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 December 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1, 2, 8 and 10-12 are rejected under 35 U.S.C. 102(b) as being anticipated by Japanese Pub. No. 10-000626 (previously made of record; hereinafter "JP '626"). Note the English abstract and computer translation previously made of record.

JP '626 discloses a method for molding a disc substrate and molding machine equipped with a disc mold for performing the method. The mold comprises a first support member and a first disc-shaped member (5) attached to the first support member (see Fig. 2). A second support member is provided, with a second disc-shaped member attached to the second support member (see Fig. 1). The second disc-shaped member faces the first disc-shaped member to form a cavity space in cooperation with the first disc-shaped member when the disc-molding mold is clamped (see for example, translation ¶ 3 and Fig. 1).

JP '626 further provides a medium flow passage (12) for temperature control formed in each of the first and second disc-

shaped members (see Fig. 1). A stamper (4) is removably attached to the first disc-shaped member (Fig. 1).

JP '626 notes that a heat insulator (13) is provided on the first disc-shaped member (Fig. 2). The heat insulator includes sections running from the center to the outer portion of the mold, including sections in the vicinity of the outer peripheral edge (see Fig. 2). The heat insulator is thicker in the vicinity of the outer peripheral edge of the first disc-shaped member. As a result of the inclusion of the heat insulator between the cavity and the medium flow passage on the first disc-shaped member, the cooling capacity of the medium flow passage in the first disc shaped member is inherently lower than the cooling capacity of the medium flow passage of the non-stamper side disc-shaped member.

JP '626 still further discloses the medium cooling passage on both disc-shaped members to include portions at a greater depth than other portions (see Fig. 1). As the heat insulating member extends from throughout the length of the mold, the medium flow passage in the second disc-shaped member has a greater depth in the vicinity of the heat insulating member as compared with other section of the medium flow passage.

Claim 10 recites a "molded product molded by the use of the disc-molding mold according to claim 1." Written as such, this

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claim is in product by process form. The determination of patentability in product by process claims is based on the product itself. The patentability of a product does not depend on its method of production. In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985); In re Brown, 459 F.2d 531, 535, 173 USPQ 685, 688 (CCPA 1972); In re Pilkington, 411 F.2d 1345, 1348, 162 USPQ 145, 147 (CCPA 1969); MPEP § 2113. Thus, in the instant case, claim 10 merely defines a disc-shaped molded product. JP '626 in disclosing a disc-molding machine and method of using such, inherently discloses a disc-shaped molded product as well.

3. Claim 10 is rejected under 35 U.S.C. 102(b) as being anticipated by Sandstrom et al. (U.S. Pat. App. Pub. No. 2002/0058084; previously of record).

As noted above in the rejection in view of JP '626, claim 10 is a product by process that merely define a disc-shaped molded product. Sandstrom discloses a molded disc-shaped product (Fig. 1), and thus anticipates claim 10.

4. Applicant's arguments filed 06 March 2006 have been fully considered but they are not persuasive.

With respect to the rejection in view of JP '626, Applicant argues that the reference fails to disclose the cooling capacity of the medium flow passage of the stamper-side member to be lower on the outer peripheral edge of the disc shaped member than the cooling capacity of the medium flow passage of the outer peripher of the non-stamper disc-shaped member.

As described above, JP '626 clearly shows the insulating member (13) to be formed as such to be substantially thicker along the outer peripheral portion of the stamper side disc shaped member than on the inner portion. Moreover, while JP '626 discloses an identical cooling passage configuration in the non-stamper disc-shaped member, JP '626 non does not disclose a heat insulating member to be provided on the non-stamper disc-shaped member (see Fig. 2). As such, the thicker insulating provided on the stamper side must inherently act to block heat flow more so along the outer periphery of the stamper side than on the non-moving side. Thus, the cooling capacity of the medium flow passage of the stamper-side disc shape member must be lower along the outer periphery due to the presence of the thicker heat insulating member as compared to the non stamper-side disc shaped member does not have any heat insulating member at all.

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It is noted that Applicant's arguments do not appear to address the rejection with respect to claim 10. Assuming that Applicant was able to distinguish the apparatus claims of the instant application from the cited prior art, claim 10 would still be anticipated by both JP '626 and Sandstrom. See the discussion above with respect to the product-by-process form of claim 10, and the patentability of such a claim.

5. Claims 3-7, 9 and 13 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

6. Applicant's amendment adding new claims necessitated the new grounds of rejection presented in this Office Action with respect to the new claims. Accordingly, THIS ACTION IS MADE FINAL. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened

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statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.


7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald Heckenberg whose telephone number is (571) 272-1131. The examiner can normally be reached on Monday through Friday from 9:30 A.M. to 6:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dr. Yogendra Gupta, can be reached at (571) 272-1316. The official fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system,

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see <<<http://pair-direct.uspto.gov>>>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at (866) 217-9197 (toll-free).

 5-15-6
Donald Heckenberg
Primary Examiner
A.U. 1722